



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,118	11/05/2001	Wolfgang Rasp	146154.00018	4936

7590 09/10/2003

David W Woodward
Powell Goldstein Frazer & Murphy
PO Box 97223
Washington, DC 20004

EXAMINER

MULCAHY, PETER D

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/913,118	Applicant(s) RASP ET AL.	
Examiner Peter D. Mulcahy	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit 1713

35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 11 and 12 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed to a use which is not a statutory category of invention.

Claims 2-10, 13 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 2 contains the language "the platelet shaped layered silica" which fails to have antecedent basis.

The language "the dry grinding process" language recited in claim 3 fails to have antecedent basis.

Claim 4 contains the language "the ground layered silica" which has no antecedent basis.

The "preferable" language in claim 5 is indefinite.

Claim 6 has no antecedent basis in the term "optionally" which renders the claim indefinite.

The "preferable" language in claim 7 is indefinite. This claim further contains the language "the mean particle size"

Art Unit 1713

which has no antecedent basis and it is indefinite as to what this language is referring to.

The language "and/or" in claims 8 and 14 is improper Markush terminology.

Claim 9 is indefinite in that it recites "preferably." Further, the "in particular" language is indefinite as well.

The "preferable" recitation in claim 10 is indefinite.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 13 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of Meyer et al., U.S. Patent 4,467,077, Middlesworth et al., U.S. H1955, Linzmeier et al., U.S. 6,214,917 or European Patent Application 669365.

The Meyer patent shows mica filled polyolefin resin composites wherein dry ground mica is shown at column 2 lines 55+. The formulating of the composition into a film as instantly claimed is rendered obvious from the disclosure at column 4 lines

Art Unit 1713

55+ where extrusion into films is clearly suggested. The particle sizes as well as concentrations as claimed are rendered prima facie obvious from this disclosure given that the ranges as claimed are suggested within the art and it is well within the skill of one of ordinary skill in the art to formulate such particles and incorporate them into the polyolefin film composition.

The Middlesworth et al. patent shows films made from polyethylenes and fillers. See the Abstract. The fillers as instantly claimed are rendered prima facie obvious from the disclosure at column 5 lines 33+ where non-smooth filler materials are suggested and mica is identified as a preferred filler. As such, one of ordinary skill in the art would find it prima facie obvious to formulate the composition and film article therefrom from this disclosure.

Linzmeier et al. shows laser markable plastic compositions. These compositions can be based on polyolefinic resins and have incorporated therein mica. It is acknowledged that a film is not expressly disclosed within this patent, however the thermoplastic moldings are of such a breadth so as to render obvious a film as claimed. See specifically column 3 line 63 - column 4. In the event that one of ordinary skill in the art would not immediately envisage applicants' instantly claimed invention,

Art Unit 1713

then the Examiner maintains that the invention is rendered prima facie obvious.

The European patent application also shows marking compositions which are based on polyolefinic resins and further incorporate therein mica. See specifically column 2 lines 55+. The recitation of a film is not clearly evident from this document. However, one of ordinary skill in the art would find the manufacture of a film prima facie obvious from this document given the broad listing of articles to be formulated from such a composition specifically at page 2 lines 10+. There is nothing within this document which would render the composition inoperable as a film and as such one of ordinary skill in the art would find it prima facie obvious to formulate a film given a reasonable expectation of success when doing so.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc

Serial No. 09/913,118

-6-

Art Unit 1713

September 9, 2003



PETER D. MULCAHY
PRIMARY EXAMINER